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10/727,667

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EXAMINER

BUI, VY Q

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/727,667
Filing Date: December 05, 2003
Appellant(s): MURPHY, KIERAN

Frank Chau
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 11/30/2009 appealing from the Office action mailed 5/29/2009.

Art Unit: 3773

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

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(8) Evidence Relied Upon

5,609,629

Fearnot

3-1997

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 4, 10-16 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Fearnot et al. (5609629).

Fearnot (Fig. 1; col. 4, lines 23-39; col. 8, line 20 to col. 9, line 21) disclose a stainless steel stent 10, for example, including a layer of soluble bioactive materials 18 (F 1; C 4, L 30-35) including a radiologic opacifier material such as a iodine-containing compound (C 8, L 46 to C 9, L12). Layer 18 is embedded between two layers 16 and 20 of the same polymer (F 1; C 9, L 64 to C 10, L 3). When layer 18 and either one layer 16 or 20 in combination is considered as the density enhancing radiologic opacifier material of a polymeric formulation (claim 10), it is clearly recognized that when soluble bioactive layer 18 dissolves, the amount of radiologic opacifier material in layer 18 of stent 10 will reduce, the radiologic profile of stent 10 will be less radiologically visible (smaller Hounsfield number) and the morphology of the surrounding tissue will be seen more clearly.

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(10) Response to Argument

The arguments filed on 11/30/2009 under 37 CFR 1.131 have been considered but is ineffective to overcome the Fearnot-5,609,629 reference.

A. The Appellant argued that: “The Examiner has therefore asserted that Fearnot simultaneously anticipates the claims (in which case no modification of Fearnot would be necessary) and renders the claims obvious following some necessary, but unspecified, modification. These two possibilities cannot coexist, and thus by rejecting the claims for either anticipation or obviousness, the Examiner has failed to use "unequivocal" language in order to clearly set out the grounds of rejection.”.

Examiner’s position: the rejection in the “Final Office Action” (paper 5/29/2009) is indeed “unequivocal” in rejecting the claims on 102(b) rejection.

The 102(b) rejection as anticipated by Fearnot et al.-5,609,629 is inherently, as clearly indicated on page 2 of the “Final Office Action”: “It is clearly recognized that when radiologic opacifier material in the soluble bioactive agent dissolves, the radiologic profile of stent 12 will be less pronounce (smaller Hounsfield number) and the morphology of the surrounding tissue will be seen more clearly.”. The 102(b) rejection is based on inherency because Fearnot-‘629 does not disclose Hounsfield number.

The 103(a) rejection over Feranot-'629 has been withdrawn.

B. The Appellant argued that: Fearnot fails to satisfy each and every element of Appellant's claim 1, and therefore cannot anticipate claim 1. In particular, Fearnot fails to satisfy

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at least the following element of claim 1: "a density enhancing radiologic opacifier embedded into said polymer".

Examiner's position: it appears that the Appellant wanted to claim that "the particles of the radiologic opacifier material are embedded into said polymer". However, the claim language does not exclude the case of a layer of radiologic opacifier material (a combination of particles of radiologic opacifier material), such as layer 18 of an iodine compound as disclosed by Fearnot-'629, which is a radiologic opacifier, is surrounded/embedded by polymer coating 20 and coating 16 of same polymer as that of coating 20 (Fearnot: Fig. 1 and C 9, L 64 to C 10, L 3).

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer. For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Vy Q. Bui/

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